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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,530	06/04/2001	Takehito Utsunomiya	B422-159	3562

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EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3692

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,530

Applicant(s)

UTSUNOMIYA, TAKEHITO

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,7 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on June 20, 2006, which paper has been placed of record in the file.
2. Claims 1, 2, 6, 7, and 11-14 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claim 12 have been considered but are not persuasive.

In response to the applicant's arguments with respect to the **35 USC § 101** rejection for claim 12, examiner submits that the functional descriptive material "A computer program" recited in the claim ***is not recorded on any computer-readable medium***. When functional descriptive material is not recorded on some computer-readable medium it becomes non-statutory because it is directed solely to Functional Descriptive Material *Per Se*.

In conclusion, for the reason set forth above, examiner decides to maintain **35 USC § 101** rejection for claim 12 as indicated in previous office action (also see details below).

4. Applicant's arguments with respect to claims 1, 2, 6, 7, and 11-14 have been considered but are moot in view of new grounds of rejection.
5. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims, as presently claimed and best understood were reconsidered in light of the "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

As to claim 12, the claimed invention is implemented as ***Functional Descriptive Material Per Se***. "A computer program" is considered as functional descriptive material,

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and “a computer program” recited in the claim is not recorded on any computer-readable medium. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

Therefore, the claim is non-statutory, because it is directed solely to Functional Descriptive Material *Per Se*.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 6, 7, and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Rudisill, U.S. Patent No. 6,816,721.

Regarding to claim 1, Rudisill discloses a service presenting apparatus for presenting predetermined service in accordance with an operation by the user, comprising:

input means for allowing an user to input access information of a portable terminal (figure 1, item 107 and column 2, lines 40-47, the device includes keypad 110 allowing an user to input access information);

access means for effecting access to the portable terminal of the user in accordance with the access information inputted by said input means (figure 1, item 114 and column 3, lines 10-15, the SCP 114 accesses the particular record associated with the wireless device 118);

inquiring means for directing the user to press a button to provide information to inquire whether or not it is allowed to make the payment for the service via a user's account on which communication of the portable terminal is charged (column 3, lines 19-30, prompting the subscriber to press a first key, e.g., "1", to authorize the transaction and a second key, e.g., "2", to refuse the transaction); and

authentication means for authenticating a response for the information by said inquiring means according to the response (column 3, lines 27-37, the authorization of the transaction is returned to the merchant);

service providing means in case that authentication means authenticates the response in order to provide the service (column 3, lines 3t-45, the authorization of the transaction is returned to the merchant and the transaction is completed, it is inherit that

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when the transaction is completed, the merchant provides products or service paid by the subscriber).

Regarding to claim 2, Rudisill further discloses database access means for accessing database (figure 1, item 114, the SCP 114 accesses the particular record associated with the wireless device 118); counting means for counting up a charge per an access to said database access means (column 2, lines 55-60, the SCP 114 maintains the amount remaining in the prepaid account associated with the device 118).

Claims 6-7 are written in method claims that contain similar limitations found in claims 1-2 above, therefore, are rejected by the same rationale.

Claims 11-12 are written in computer medium and computer program and contain similar limitations found in claim 1 above, therefore, are rejected by the same rationale.

Regarding to claim 13, Rudisill discloses a network system in which a server computer and a terminal is interconnected via a network and to provide predetermined service in accordance with an operation of the user (figure 1 and column 2, lines 35-65, the device 118 is connected to the SCP 114, SMSC 120, via a mobile switching center MSC 122),

wherein said server computer comprising:

input means for allowing an user to input access information of a portable terminal (figure 1, item 107 and column 2, lines 40-47, the device includes keypad 110 allowing an user to input access information);

access means for effecting access to the portable terminal of the user in accordance with the access information inputted by said input means (figure 1, item 114 and column 3, lines 10-15, the SCP 114 accesses the particular record associated with the wireless device 118);

inquiring means for directing the user to press a button to provide information to inquire whether or not it is allowed to make the payment for the service via a user's account on which communication of the portable terminal is charged (column 3, lines 19-30, prompting the subscriber to press a first key, e.g., "1", to authorize the transaction and a second key, e.g., "2", to refuse the transaction); and

authentication means for authenticating a response for the information by said inquiring means according to the response (column 3, lines 27-37, the authorization of the transaction is returned to the merchant);

service providing means in case that authentication means authenticates the response in order to provide the service (column 3, lines 3t-45, the authorization of the transaction is returned to the merchant and the transaction is completed, it is inherit that when the transaction is completed, the merchant provides products or service paid by the subscriber);

and wherein said terminal comprising:

receiving means for receiving an inquiry by said inquiring means; and transmitting means for transmitting the information input by the user (column 3, lines 19-30, the subscriber receives message displaying on the wireless communication device 118 to

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inform the subscriber of the purchase price; the subscriber presses a first key, e.g., "1", to authorize the transaction and a second key, e.g., "2", to refuse the transaction).

Regarding to claim 14, Rudisill further discloses database access means for accessing database (figure 1, item 114, the SCP 114 accesses the particular record associated with the wireless device 118); counting means for counting up a charge per an access to said database access means (column 2, lines 55-60, the SCP 114 maintains the amount remaining in the prepaid account associated with the device 118).

Conclusion

10. Claims **1, 2, 6, 7, and 11-14** are rejected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

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Washington, DC 20231


Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany
Street, Alexandria, VA, First Floor (Receptionist).


NGA NGUYEN
PRIMARY EXAMINER

September 1, 2006